



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,566	12/12/2003	Reinhard Lihl	LVIP:108US	1877

7590 10/17/2005
Robert P. Simpson, Esq.
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221

EXAMINER

PETERSON, KENNETH E

ART UNIT PAPER NUMBER

3724

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,566

Applicant(s)

LIHL ET AL

Examiner

Kenneth E. Peterson

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-102)
- 6) ☐ Other: _____.

1. Claims 2-7 are objected to because the titles are incorrect. The titles should be changed to correlate to parent claim 9.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the European patent to Niesporak (EP0544181), who shows a microtome with most of the recited limitations including a sensing device (20,44) controlling a feeder device (50) at different speeds (coarse speed, slicing speed).

Niesporak determines the position of the blade relative to the sample via a contact sensor (20) rather than a light barrier. Examiner takes Official Notice that it is well known to employ a light barrier to facilitate the optimal positioning between a knife and a workpiece. An example of this is the patent to Mohr '886 (figure 6). It would have been obvious to one of ordinary skill in the art to have modified Niesporak by replacing his contact sensor with a light barrier, as is well known and taught by Mohr, in order to increase reliability (non-contact sensors are less prone to breaking), and also because the two different type of sensors are art-recognized equivalents known for the same purpose. See MPEP 2144.06.

4. Applicant's arguments have been fully considered but they are not persuasive.

Applicant has overcome the 102b rejection by Mohr.

Applicant argues against the Niesporak in view of Mohr rejection under 103.

Applicant states that Niesporak has a "lack of reference to any sample". This argument is not understood. Niesporak's sample (22) is clearly contacted by the sensor (20) such that the spacing between the knife and the sample is known. Perhaps a look at a related Niesporak case in English, 5,535,654, will help clarify this point.

Applicant argues that Mohr and Niesporak are non-analogous. However, both patents are directed to sensors that control the positioning of the knife so that it is adjacent the workpiece prior to initiation of the cutting stroke. This type of knife and sensor combination is not particularly common, so it is safe to say that both patents share a very narrow field of endeavor, even if some other details of the respective knives are different.

Applicant argues that Mohr and Niesporak are solving different problems. It is true that Niesporak's sensor regulates the approach of the blade, whereas Mohr's sensors arguably regulate the retreat of the blade. However, they both solve the same problem of ascertaining the spacing between the blade and the next workpiece, such that the blade can be positioned next to the workpiece and cutting can initiate more quickly during the next cutting cycle.

5. Made of record but not relied on is a patent to Leighton showing coarse feeding.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

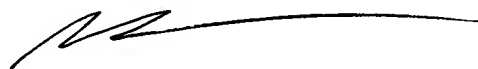
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 571-272-4512. The examiner can normally be reached on Mon-Thur, 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kp
October 13, 2005



KENNETH E. PETERSON
PRIMARY EXAMINER